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REMARKS / DISCUSSION OF ISSUES

Claims 4-15 are pending in the application.

The Examiner asserts that the applicants have not complied with the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120. The applicants respectfully traverse this assertion, and respectfully request the Examiner's attention to the applicant's request for filing a continuation under 37 CFR 1.53(b) submitted on 13 November 2001. At page 1 of 2 of the request, the applicants specifically state:

"[X] Amend the specification by inserting before the first line as a centered heading: --Cross Reference to Related Applications--; and insert below that as a new paragraph --This is a [X] continuation [] divisional of application Serial No. 09/031,695, filed February 27, 1998,--"

The applicants respectfully request the Examiner's acknowledgment of this claim for priority.

The Examiner has rejected claims 4-15 under the judicially created doctrine of obviousness-type double patenting over claims 1-5 of USP 6,354,947. The applicants respectfully traverse this rejection. USP 6,354,947 corresponds to application 09/031,695, and is the parent application of this continuing application, as noted above. This application contains method claims that are patentably distinct from the apparatus claims of USP 6,354,947. Contrary to the assertions in the Office action, the instant application does not contain claims to apparatus, system, transmission means, signal means, etc. as claimed in USP 6,354,947. The applicants respectfully maintain that the method claims of this application are patentably distinct from the apparatus claims of the parent application because the method of this application can be practiced without necessarily including each of the elements of the claimed apparatuses in the parent claim.

The Examiner has rejected claims 4 and 8 under 35 U.S.C. 102(a), and claim 12 under 35 U.S.C. 103(a) over Gilboa (WO 9603188). The applicants respectfully traverse this rejection in view of amended claims 4, 8, and 12.

PHN16,257A Amendment 4.325 - MAC

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The applicants teach and claim the activation of a service field at a host system in response to an item coming within proximity of the host. Each of claims 4, 8, and 12 are amended to recite transmitting information from the host to the item, for storage at the item.

Gilboa teaches a game system with a game-board that detects the location of game-pieces on the board. Each game piece, or type of piece, communicates a unique signal to the game board of the host system, so that each piece can be identified. Gilboa does not teach transmitting information from the host system to the game pieces, and such a communication, from the game to the game piece, would be inconsistent with the conventional operation of a game system.

Because Gilboa does not teach or suggest the transmission of information to the item, for storage at the item, the applicants respectfully request the Examiner's reconsideration of the rejection of claims 4 and 8 under 35 U.S.C. 102(a), and claim 12 under 35 U.S.C. 103(a) over Gilboa.

The Office action rejects claims 5-7, 9-11, 13-15 under 35 U.S.C. 103(a) over Gilboa and Sitrick (USP 5,830,065). The applicants respectfully traverse this rejection.

The applicants respectfully maintain that there is no suggestion in the prior art to combine Gilboa and Sitrick in the manner proposed by the Examiner to achieve the applicants' claimed invention.

The Examiner's attention is requested to MPEP 2143, wherein it is stated:

"THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION ... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." And, "FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS ... The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).... Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.)."

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Gilboa and Sitrick both teach gaming systems. In Gilboa, the location and orientation of each game piece on a board is detected, and the gaming system uses these locations and orientations to control the flow of the game. In Sitrick, an image storage card is provided for use in an arcade. Sitrick's card contains an image or speech of the card user and can also be used as a cash-debit card. When the user enters the image storage card into a card reader of the game system, the game system deducts the cost of the game from the card, and uses the stored image and speech information to generate computer images of the card user as a character in the game.

The applicants' invention relates to a scheme for activating programs on a computer without requiring any actions on the user's part. As taught by the applicants, when a user who is carrying an item enters the proximity of a host system, the host system activates an application program/service field at the host, thereby avoiding the user having to know how to start a program on the host. To further provide a sense of familiarity, the host is configured to display an icon corresponding to the shape or symbolism of the item that the user is carrying. Once the program is started, the user interacts with it in the normal manner. To further facilitate this sense of familiarity, the item that the user carries is configured to be able to store information from prior encounters with the host, so that when the user encounters another host having the applicants' invention, the other host can appear to be an extension of the prior host.

With specific regard to claims 4, 8, and 12, upon which claims 5-7, 9-11, and 13-15 depend, as discussed above, Gilboa's game pieces are not configured to receive information from a host system, and such a configuration is contrary to the conventional use of game pieces in a gaming system. Sitrick teaches an image card that can receive information from the host for storage on the card, but there is no suggestion in the prior art for modifying game pieces that are used in a board game, such as taught by Gilboa, with information receiving and storing capabilities.

In claims 5, 10, and 13, the applicants claim enabling the user to activate information processing operations at the host related to the associated service field. As noted above, the

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applicants' invention allows a user to use programs on the computer without having to know how to activate the programs.

Neither Gilboa nor Sitrick address the activation of information processing operations related to associated service fields based on the detection of an item in proximity to a host system. The Office action acknowledges that Gilboa does not teach activating information processing operations at the host. The Office action states that Sitrick's use of a camera to store the image and speech information constitutes the applicants' claimed information processing operations. Sitrick does not teach that this activity occurs in response to the detection of an item in proximity to the host.

The Office action asserts that it would have been obvious to one of ordinary skill in the art to provide the features of Sitrick's invention "into the Gilboa type system for editing purposes" (Office action page 6, line 1). The applicants respectfully disagree with this assertion, because there is no suggestion in the prior art that a board game that uses game pieces, as taught by Gilboa, should be equipped with information processing capabilities that are associated with a service field that is activated when the game piece is in proximity of the host. The mere fact that Sitrick provides information processing capabilities does not suggest the desirability of providing such a feature to the board game of Gilboa.

Further, with regard to claim 5, Gilboa specifically teaches that the display screen of the host provides a background scene for the activities on the board, as illustrated in Gilboa's FIG. 22 (see also Gilboa, page 12, lines 3-12). The applicants respectfully maintain that the configuration of Gilboa's board and screen is specifically designed to provide an audio-visual backdrop to a game-board, and is unsuitable for providing conventional information processing capabilities, such as the asserted editing features of Sitrick. This unsuitability for conventional information processing capabilities further argues against the desirability of combining these references.

With regard to claims 6, 11, and 14, the applicants specifically claim the transmission of host-generated results related to the service field that is activated in response to the item's proximity to the host.

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Gilboa's board game does not transmit information to the game-pieces, and such a transmission is contrary to the conventional concept of game-pieces and board games. Sitrick teaches the transmission of data to an image card that is plugged into a card reader/writer. The Office action asserts that because Sitrick provides this feature, it would be obvious to include it in Gilboa. As noted above, MPEP 2143 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." The applicants respectfully maintain that the prior art does not suggest the desirability of modifying Gilboa's game to transmit information to Gilboa's game-board pieces.

Claims 7, 9, and 15 claim the use of iconized representations of the item at the host.

The Office action notes that Sitrick teaches the use of icons. As in the above remarks, the applicants note that there is no suggestion in the prior art to modify Gilboa with this feature of Sitrick. The applicants again note that Gilboa's invention is specifically designed to provide an audio-visual backdrop to the board game that uses detectable game-board pieces. The applicants respectfully maintain that the icons in Gilboa's backdrop would be contrary to Gilboa's intended purpose of providing an audio-visual presentation that simulates background scenes during the play of a game.

Based on the above remarks, the applicants respectfully request the Examiner's reconsideration of the rejection of claims 5-7, 9-11, 13-15 under 35 U.S.C. 103(a) over Gilboa and Sitrick.

The Office action rejects claims 4-15 under 35 U.S.C. 103(a) over the applicants' admitted prior art (AAPA) and Redford (USP 5,788,507). The applicants respectfully traverse this rejection. This rejection was addressed in the applicants' preliminary amendment. Because the applicants' remarks in the preliminary amendment were apparently unpersuasive, and because the claims are amended herein, the applicants withdraw the arguments presented in the preliminary amendment of 13 November 2001.

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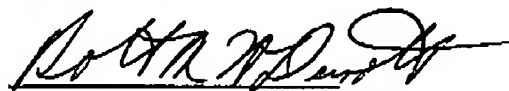
The applicants respectfully note that the admitted prior art includes Gilboa (Applicants' specification, page 2, lines 5-10), and thus the remarks above regarding the distinction of the amended claims over Gilboa apply.

Redford teaches a remote control device that a user can use to remotely control a host device to display information related to a printed publication that is associated with the remote control device. Redford is silent with regard to transmitting information from the host to the remote control device.

Because neither the applicants' admitted prior art, nor Redford, individually or collectively, teach or suggest activation of a service field at a host system in response to an item coming within proximity of the host, and transmitting information from the host to the item, for storage at the item, as specifically claimed in each of the applicants' independent claims, the applicants respectfully request the Examiner's reconsideration of the rejection of claims 4-15 under 35 U.S.C. 103(a) over the applicants' admitted prior art and Redford.

In view of the foregoing, the applicants respectfully request that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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